

REMARKS/ARGUMENTS

Drawing Objection

The drawings have been objected to under 37 C.F.R. 1.83(a), and a proposed drawing correction has been required in reply to the Office Action. Specifically, the Office Action has alleged that the drawings do not show every feature of claims 28-54, 68, and 69.

Although Applicants respectfully submit that the drawings show every feature of claims 28-54, 68, and 69, the drawings have been amended to include a new drawing, Fig. 12, to further clarify the features of claims 28-54, 68, and 69. Additionally, the specification has been amended to reference the addition of Fig. 12. Thus, Applicants respectfully submit that the drawing objection has been overcome.

Claim Rejections

Claims 1-8, 10-11, 13-19, 22-35, 37-38, 40-46, 49-54, 57, 59-60, 62-63, and 66-72 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Number 6,517,432 ("Jaffe"). Claims 9, 20-12, 36, 47-48, and 64-65 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Jaffe in view of U.S. Patent Number 6,375,568. Jaffe and the present application are owned by the same assignee, WMS Gaming Inc. The assignment for the present application has been recorded on November 14, 2000, and a complete microfilm copy is available on the Reel 011287 / Frame 0579. The assignment for Jaffe has been recorded on March 21, 2000, and a complete microfilm copy is available on the Reel 010693 / Frame 0328.

One method of overcoming an 102(e) rejection is to perfect priority under 35 U.S.C. 120 by amending the specification of the application to contain a specific reference to a prior application, within the time periods set in 37 C.F.R. § 1.78(a), and by establishing that the prior application satisfies the enablement and written description requirements of 35 U.S.C. § 112, first paragraph. *See*, Manual of Patent Examining Procedure ("MPEP"), Eighth Edition, Incorporating Revision Number 1 (dated February 2003), Section 706.02(b), page 700-24, part (F).

As described below in more detail, the present application is being amended to show that it is a continuation-in-part of Jaffe, and therefore Jaffe cannot be used to reject the present

application under either sections 102(e) or 103(a). Thus, both rejections, under section 102(e) and under section 103(a), have been overcome.

The specification has been amended to perfect priority to Jaffe, by adding the statement that the present application is “a continuation-in-part of U.S. Patent Application Serial Number 09/531,712 filed March 21, 2000 and entitled “Gaming Machine With Moving Symbols On Symbol Array,” now U.S. Patent No. 6,517,432.” Further, for the reasons set forth below, it is respectfully submitted that the reference is proper and being made in a timely manner.

The current version of 37 C.F.R. § 1.78(a)(2) requires the specification of a later-filed nonprovisional application – that is claiming priority under 35 U.S.C. § 120 from a prior application – to contain, or be amended to contain, a specific reference to the prior application within four months of the filing date of the later-filed application. However, the MPEP clearly states that the four-month deadline is only applicable to patent applications filed on or after November 28, 2000. For example, Section 201.11 of the MPEP notes that “The time period requirement under 37 C.F.R. 1.78(a)(2) and (a)(5) is only applicable to utility or plant applications filed on or after November 29, 2000.” *See*, MPEP, page 200-73, Subsection V; *see also*, MPEP at page 200-65, part (E), lower left-hand column. Because the present application was filed prior to November 29, 2000, the four-month deadline is not applicable in this case.

The prior application to Jaffe satisfies the enablement and written description requirements of 35 U.S.C. § 112, first paragraph, because the prior application to Jaffe discloses the elements claimed in the present invention, as acknowledged in the Office Action dated August 27, 2003. Additionally, the prior application and this continuation-in-part application now have at least one common inventor (*i.e.*, Jaffe). *See* MPEP, Section 201.08, page 200-62, part (A).

After further considering the Examiner’s rejections based on Jaffe and consulting with WMS Gaming Inc., the assignee, it was determined that Mr. Joel R. Jaffe should be listed as a co-inventor of the current application. Both Mr. Jaffe and Mr. Wayne H. Rothschild work for WMS Gaming Inc. in the area of product development. Please note that U.S. Patent Application Serial No. 09/531,712, from which the Jaffe patent has issued, was copending with the present

application. In particular, the present application was filed in the Patent Office on November 14, 2000, which was before the February 11, 2003 issuance of the Jaffe patent.

Thus, it is requested that Mr. Joel R. Jaffe be added as a co-inventor to the current application. Attached to this response are the following documents required for amending the inventorship of the current application, pursuant to 37 C.F.R. § 1.48, to add Mr. Jaffe as an inventor: Statement of Inventorship Error by Joel R. Jaffe pursuant to 37 C.F.R. § 1.48(a)(2), Supplemental Declaration and Power of Attorney, Consent of Assignee under 37 C.F.R. § 3.73(b) to Correction of Inventorship, and Supplemental Assignment.

A terminal disclaimer has also been attached to address any possible rejections for double patenting in view of Jaffe. However, the filing of the terminal disclaimer in the present application is not an admission that any claims of the present application would have been properly rejectable or invalid for double patenting in view of the prior patent referred to in the terminal disclaimer. See, for example, Section 804.02 of the MPEP, a portion of which is quoted forth below:

The filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). The court indicated that the “filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.”

Subsection II, page 800-32.

Conclusion

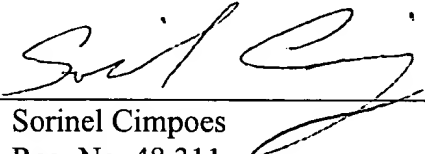
It is the Applicants' belief that all the pending claims are now in condition for allowance, and thus reconsideration of this application is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

Enclosed is a check for \$260.00, which covers the fee for the petition for extension of time, the supplemental assignment, and the terminal disclaimer. Should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47079-00063.

Respectfully submitted,

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By


Sorinel Cimpoes
Reg. No. 48,311

Jenkins & Gilchrist, P.C.
225 West Washington Street, Suite 2600
Chicago, Illinois 60606-3418
Attorneys for Applicant
(312) 425-8542